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EXAMINER	
AMSBURY, WAYNE P	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/734,886	Applicant(s) HOELZLE ET AL.	
	Examiner Wayne Amsbury	Art Unit 2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 June 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-61* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *13 December 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5,6,7,8*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

CLAIMS 1-61 ARE PENDING

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9-10, 12, 15 and 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Yahoo.com home page, October 17 1996 and typical search.

It is considered that this reference, as exemplary of a typical web-based search engine, clearly anticipates some of the claims, but in the interest of compact prosecution, the claims are mapped to the teachings of the reference as follows:

As to **claim 1**, the initial document (home page) is a document currently accessed by a user at the time of display. It is a form that is filled in with a selection of one or more words, and clicking on the *search* button treats the selection as a search query. Search results are retrieved (pages 2-3) and presented to the user. Alternately, the results of the initial results (pages 2-3) comprise a document with many words that may be selected to generate a search query that generates further results presented to the user. Typically this process may be iterated at length.

As to **claim 2**, the action that generates a search from such a page is a pointer click on a highlighted term (or terms).

As to **claims 3-4**, the initial search term is unrestricted and may be a single search term. Official notice is taken that if this is so, the highlighted term portions of a returned list of query results may be a single term. Alternately, such portions are effectively the URL of a Web site. (The reference also includes such terms as explicit strings.)

As to **claims 5-6**, some of the selections of yahoo.com are phrases.

As to **claim 7**, it is clear that the three individual words of the initial search query example are combined to determine search results and thus they are inherently combined to form the search query.

As to **claim 9 and 12**, the sections of Yahoo.com pages 2-3 that are selectable correspond to paragraphs.

As to **claim 10**, it is clear that the terms **state, tax,** and **rates** are also textual concepts.

As to **claim 15**, it is clear that Yahoo parses the search string to determine concepts that are separated and used in arbitrary combinations in determining search results.

As to **claim 18**, servers of the underlying network of the Web are used to support Web-based search services such as Yahoo.com.

As to **claim 19**, the content and form of the home page expresses a hierarchical directory.

The elements of **claims 20-24** are rejected in the analysis above and these claims are rejected on that basis.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8, 13-14, 17, 25-32 and 37-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yahoo.com home page, October 17 1996 and typical search.

As to **claims 8 and 13, it would have been obvious** to one of ordinary skill in the art at the time of the invention to omit words that are unnecessary for obtaining relevant search results, because by their definition, they are unnecessary.

As to **claims 14 and 17**, the Yahoo.com example provided does not explicitly teach the use of an "entire" document, but it is certainly possible that only one search result would be returned. In that case, the entire body of the document would be the base for further search.

It is also possible that a document might contain only one sentence and/or one paragraph. Thus the distinction between sentence, paragraph, and entire document are specious absent further limitation. There is no evidence in the Specification or the context of the claims that would require any significant distinction between the textual components of sentence, paragraph, or document. **It would have been obvious** to one of ordinary skill in the art at the time of the invention to apply an iterated search such as that of Yahoo.com to an entire document containing one sentence and/or one paragraph, because this functionality is already in place for embedded sentences and paragraphs, and it would be more efficient on the grounds that separating these text fragments would not be required.

As to **claim 25**, Yahoo does not explicitly provide a **score** for each link as represented by the listed items but they are ranked [page 2 TOP 20 WEB RESULTS]. To the extent that determining a score is not anticipated by listing the initial results in order, **it would have been obvious** to one of ordinary skill in the art at the time of the invention to determine a score in order to rank results and provide the most significant results to the user in the order of their significance.

Each presentation of a segment of the search results, (5,670,000 in the example), is a document containing ranked links.

Yahoo does not explicitly state that all of the search result pages are *prefetched*, and it is possible that only their URL is prefetched. It is also possible but not explicit in Yahoo.com that some or all of the initial search result pages are cached and thus prefetched.

As clearly indicated by the results of pages 2-3, some of the sites are cached [result #1]. To the extent that prefetching is not anticipated, **it would have been obvious** to one of ordinary skill in the art at the time of the invention to prefetch at least the most significant documents because access to the most significant documents is then immediate and efficient for the user, and it would be efficient for the server to prefetch documents frequently-accessed by the user community so that they would not need to be fetched repeatedly and thus inefficiently.

The elements of claims 26-28 are rejected in the analysis above and these claims are rejected on that basis.

As to **claim 29**, if a document has not been prefetched, the only way to meet a user selection is to retrieve it. As to **claim 30**, fetching inherently involves address lookup.

The elements of claims 31-32 and 37-38 are rejected in the analysis above and these claims are rejected on that basis.

As to **claims 39-40**, Yahoo.com clearly receives input from the user [state tax rates] that determines the ranking of the results, and TOP 20 inherently involves a degree of match.

As to **claim 41**, Yahoo.com clearly does not apply a threshold in order to limit the number of search results in this example, since there are 5,670,000. This number is itself motivation for applying a threshold in order to limit the number of results. However, the number *presented* is clearly limited (to 20), which is a threshold for presentation but not necessarily for scores per se. It is certainly possible that the found results of a search are all of poor quality.

It would have been obvious to one of ordinary skill in the art at the time of the invention to limit search results with a threshold on the score because this would ensure at least a known degree of quality for the retrieved results and thus preclude wasting the resources required for retrieval on items of limited use.

The elements of **claims 42-44** are rejected in the analysis above and these claims are rejected on that basis.

As to **claim 45**, the Yahoo.com Web site is a client of the servers of the Web.

3. Claims 11, 16 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yahoo.com home page, October 17 1996 and typical search in light of Lazarus et al (Lazarus), US 6,134,532, 17 October 2000.

Lazarus is directed to adaptive matching of users to advertisement Web sites based on observed behavior, and is directed to searching to find relevant or interesting information [COL 2 lines 52-60] in the context of advertising selection. Yahoo.com does not explicitly address measures of clickthrough rate and popularity for Web sites.

Clickthrough is the number of users that click on a link (a "banner advertisement") that is presented to users [Lazarus COL 1 lines 31-43] and is the best measure of the effectiveness of the link (and hence the advertising techniques).

As to **claims 34-36**, Clickthrough is clearly a measure of popularity of a link with users. **It would have been obvious** to one of ordinary skill in the art at the time of the invention to use clickthrough as the basis of a score for rating search results or other keywords in searches because it directly measures user choice.

As to **claim 33**, the clickthrough is associated with the linking document but determines a score for the linked document as well.

As to **claims 11 and** 16, Lazarus applies a vector space representation that summarizes the context of searches [SUMMARY, COL 4].

4. **Claims 46-61 are rejected under 35 U.S.C. 102(b) as being anticipated by van Hoff, US 5,822,539, 13 October 1998.**

It is considered that some claims are clearly anticipated by van Hoff, but in the interest of compact prosecution, the claims are mapped to the reference as follows:

As to **claim 46**, van Hoff is directed at annotating a document with Web links [ABSTRACT; SUMMARY]. In particular, the method of van Hoff analyzes where links should be added and provides hypertext link annotations [COL 3 lines 4-21].

In more particular, a dictionary of references is used in a preferred embodiment to link to sources of information. The dictionary entries correspond to "identified pieces of information" in the claims.

As to **claim 47**, FIG 4 depicts a phrase ("music synthesizers") that is used to generate a link. This phrase is also a product and the name of a category of products.

As to **claim 48**, van Hoff is quite general, as it will base annotations on searches for characters, phrases, numbers, and the like [COL 7 lines 12-23]. A name is simply a word or phrase, and it has no other lexicographic support in the specification.

As to **claims 49-50**, van Hoff teaches that the cross-reference dictionaries may be supplied by various entities, including educational institutions, publishers, good Samaritans, and the like [COL 9 lines 59-67]. Official notice is taken that publishers produce and sell products that are linked to reviews. Other such sources include Amazon, and general catalogues.

As to **claim 51**, van Hoff applies parsing that inherently locates key terms within text segments [COL 4 lines 39-46 and elsewhere].

As to **claim 52**, the dictionary resides on a remotely located server [COL 4 lines 9-21].

As to **claim 53**, the annotation directory is clearly searched for a *match pattern* [FIG 2], and it is implicit in the use of the term "dictionary" in van Hoff that it is hierarchical.

As to **claims 54-55**, the annotations of van Hoff modify the document, and the annotated document at least is a document separate from the original.

5. **Claims 1-10, 12-15, 17-32 and 46-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over van Hoff, US 5,822,539, 13 October 1998 in light of Yahoo.com home page, October 17 1996 and typical search.**

While van Hoff does not address the details of prefetch and the use of a browser search engine, he does produce information in such a way that the merged document is displayable by existing Web browsers [COL 3 lines 1-3], and the client is embodied as a Web browser [COL 4 lines 9-21 and elsewhere]. **It would have been obvious** to one of ordinary skill in the art at the time of the invention to apply a search engine such as Yahoo because it is efficient to use an available one rather than developing a custom design.

It is considered that the elements of the claims are rejected in the analysis above and these claims are rejected on that basis.

6. **Claims 11, 16 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over van Hoff, US 5,822,539, 13 October 1998 in light of Yahoo.com home page, October 17 1996 and typical search and in further light of Lazarus et al (Lazarus), US 6,134,532, 17 October 2000.**

These claims include the elements such as clickthrough that were not addressed in Yahoo. It is considered that the elements of the claims are rejected in the analysis above and these claims are rejected on that basis.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Amsbury whose telephone number is 703-305-3828. The examiner can normally be reached on M-TH 7-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WPA

WAYNE AMSBURY
PRIMARY PATENT EXAMINER